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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,887	04/20/2001	Kevin R. Willett	85939.000193	4285
23387	7590	02/18/2004	EXAMINER	
Stephen B. Salai, Esq. Harter, Secrest & Emery LLP 1600 Bausch & Lomb Place Rochester, NY 14604-2711			UHLIR, NIKOLAS J	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b> 09/839,887	<b>Applicant(s)</b> WILLETT, KEVIN R.	
	<b>Examiner</b> Nikolas J. Uhler	<b>Art Unit</b> 1773	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-20, 23, 24, 26, 33-44, 46-50, 52-56, 58-61 and 63-65.

Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

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**Continuation of box 5(c):**

The applicants request for consideration has been considered but does not place the case in condition for allowance. The applicant's in their request for reconsideration raised the following arguments with respect to the previously applied 35 U.S.C 103(a) rejections of the instant claims (arguments are summarized for the sake of brevity):

1. The requirement that a powder be colliquefiable or heat fusible is not an intended use limitation. Rather, it further limits and defines the structure of the powder. All powders are not colliquefiable, i.e. gunpowder and sawdust are powders that are not colliquefiable. The fact that Junker teaches that the powder is designed to form islands on its surface is indicative that it is not colliquefiable.
2. The examiner is improperly picking and choosing from the references, in particular Ford et al. Specifically, the examiner, by ignoring the specific coating chemistry of Ford, is picking and choosing teachings from the Ford reference rather than considering the reference as a whole.
3. The mere fact that a reference such as Junker does not exclude a modification does not render that modification obvious. Rather there must be some teaching of motivation to one of ordinary skill in the art to make the proposed modification.
4. The fact that Junker lists plastics and rubbers as suitable materials for forming the weather seal and thus necessarily includes thermoplastics and thermoset rubber is strained at best. It is difficult to find a teaching of thermoplastic rubber.
5. The examiner has ignored the fact that Ford utilizes a specific coating chemistry to coat both the seal and trim portion and has not explained why one of ordinary skill in the art would not have followed the suggestion of Ford and used the specific coating chemistry taught by the reference to modify Junker.
6. The examiner's assertion that the coating of Junker will be "glossy to some degree" is a conclusory statement. There is no objective evidence to support this conclusion.
7. Coating of the metal layer of Katoh with the coating composition of Junker is directly contrary to Katoh, as it is the desire of Katoh to provide a weather seal with an exposed metal surface. To cover the metal surface with the powder coating would prevent Katoh from achieving its desired purpose and thus cannot be sustained as a rejection under 35 U.S.C 103. Further, as the exposed metal portions of Katoh are not visible, there is no motivation to coat their surface with the Junker coating.
8. The metal layer of Katoh is not equivalent to the metal layer claimed, as the metal layer of Katoh is much thinner 10-100 times thinner than the polymeric substrate.

These arguments are unpersuasive. Regarding argument #1, the examiner concedes that the terms "colliquefiable" and "heat fusible", are property limitation and are not an alternative use. The examiner further notes the applicants argument with respect to the functionality of these terms in imparting structure to the final product

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coating after fusion or colliquiefaction. However, the examiner notes that the previous interpretations of powder coating were made in lieu of the fact that the claims were previously directed to a final product coating, namely a contiguous colliquiefaction of a powder coating.

However, the applicant has not positively claimed the structure of the final product coating after colliquiefaction/heat fusion. Rather, the applicant has claimed the structure of the intermediate powder coating. More generally, the applicant is claiming a powder that is *capable* (emphasis added) of being melted and/or heat fused. There is nothing in the claims now which requires a specific structure of the coating after the powder has in fact been heat fused and/or colliquiefied.

Bearing the above in mind, Junker specifically teaches coating various portions of a weather seal with a powder and subsequently melting and fusing the powder (see Junker, column 2, lines 40-47). Thus, the physical requirement that the powder be "colliquiefiable" and/or "heat fusible" is met. The examiner acknowledges that the Junker coating is designed to form "islands" of polymer. However, the applicant **has not** positively claimed the structure of the colliquiefied/fused coating. Thus, the examiner maintains that the Junker coating reads on the instant claims.

9. With respect to argument #2 (the applicant's picking and choosing argument). The examiner acknowledges that references must be considered as a whole and that it is improper to pick and choose teachings from any particular reference while utilizing the applicant's specification as a guide. In essence, the applicant is arguing that one of ordinary skill in the art, considering the references as a whole, would have no motivation

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to make the proposed modification absent knowledge of the disclosure in the applicant's specification. The examiner respectfully disagrees. The examiner acknowledges that Ford does in fact teach the use of a very specific solution chemistry for use in applying a colored coating to the surface of the trim and sealing portions of a weather seal.

However, the examiner maintains that Ford was simply utilized to explicate a known desire in the art, namely the desirability of a colored coating on both the trim and seal portion of the weather seal so as to achieve the aesthetic benefit of matching the paintwork of the vehicle to that of the trim. Nowhere in Ford is it suggested that this goal can only be achieved by application of its specific solution chemistry. Given Ford's elucidation of the desired aesthetic benefit, Junkers disclosure of a weather seal having trim and seal portions made of rubber or plastic, and Junkers disclosure that the powder coating can adhere to rubbers/plastics, one of ordinary skill in the art looking at Junker and Ford alone would have had motivation with a reasonable expectation of success to coat both the seal and trim portions of the Junker weather seal with the Junker powder coating. Thus this argument is not persuasive.

10. Regarding argument #3 (non-exclusion of a modification does not make it obvious). The examiner wholeheartedly agrees that non-exclusion of a modification does not make the modification obvious. This argument is apparently in response to the examiner's assertion in the final action that there is no objective evidence in Junker that limits the location of the powder coating to a single portion of the weather seal. The examiner respectfully believes the applicant misunderstood the examiners rebuttal of their prior argument. To clarify, the examiner's statement that Junker does not expressly

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limit the location of the powder coating was not an assertion that such a non-disclosure made this modification obvious. Rather, it was an assertion that Junker does not teach away from such a modification. More succinctly, the examiners argument was that the proposed modification would not "destroy" or "contradict" the reference. Accordingly, this argument is unpersuasive.

11. Regarding argument #4 (support for thermoplastic rubber is difficult to find). The examiner respectfully disagrees with applicant's assertion that it is difficult to find disclosures of thermoplastic rubbers. Junker, column 2, line 48 (though directed to the coating and not the weather seal), clearly provides evidence that thermoplastic rubbers are known in the art. Thus, this argument is not persuasive.

12. Regarding argument #5 (examiner ignores solution chemistry of Ford). The examiner feels this argument has been effectively addressed as set forth above for argument #2.

13. Regarding argument #6 ("glossy to some degree" is a conclusory statement). The examiner agrees that the assertion that the coating of Junker will be "glossy to some degree" is a conclusory statement, however it is reasonable and certainly supportable under the circumstances. Applicant in claim 19 requires the powder coating to form a colliuefaction having a glossy appearance. While the examiner acknowledges that Junker does not disclose this requirement, it is important to note that the requirement that an article have a "glossy appearance" is a very broad requirement, as the specific level of gloss is not specified. Thus, a colliuefaction that is only marginally glossy reads on the claim. It is further noted that the requirement that the

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powder coating form a colliqufaction that has a glossy appearance does not positively claim a contiguous or continuous colliqufaction. Thus, the applicant is only requiring each individual colliqufaction formed from each individual powder particle to have a gloss appearance, and is not requiring the colliqufaction to be a continuous layer having a gloss appearance. Thus, this argument is unpersuasive.

14. Regarding argument #7 (coating of the metal layer of Katoh with the Junker coating is contrary to the express purpose of Katoh). The examiner respectfully disagrees. The applicant has asserted that it is the goal of Katoh to form a weather seal having an exposed metal surface. Aside from the fact that the examples asserted by Katoh have an exposed metal surface, the examiner finds no evidence that this exposed surface is the "express" goal of Katoh. Rather, the goals of Katoh are disclosed at column 1, line 50-column 2, line 3. Specifically, Katoh desires to prevent damage to the paintwork of a vehicle during weather seal installation, to insure a proper fit between the body and the weather seal, to improve noise absorption via the weather seal, to eliminate galvanic corrosion between the metal body and the metal of the weather seal, and to make a lighter weather seal. More specifically, Katoh is trying to improve the portion of the weather seal coating that comes into contact with the body of the automobile. Nothing is said as to the impermissibility of coating the exposed metal layer, or that doing so will frustrate the goals of the reference. The proposed modification of Katoh to coat the exposed portion of the metal layer with the coating disclosed by Junker does not contradict this improvement, and is predicated on the teaching in Ford that it is desirable to match the color of trim strips to the paintwork of


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the vehicle, and the teaching in Katoh that polymers similar to those in the Junker powder coating can adhere to the metal layer. Thus, one of ordinary skill in the art would have motivation with a reasonable expectation of success to perform the proposed modification.

The examiner also rebuts the combination of Katoh with Junker and Ford by stating that the weather seal of Katoh is not visible and thus one of ordinary skill in the art would have no motivation to make the proposed modification. The examiner respectfully disagrees, as it is apparent that in at least some embodiments of Katoh, the, portions of both the seal and trim portion are visible (see figure 4c of Katoh). Thus, this argument is unpersuasive.

15. Regarding argument #8 (non-equivalence of Katoh metal layer to claimed metal layer). The examiner acknowledges the asserted physical differences between the metal layer in the instant invention and that utilized in Katoh. However, these physical characteristics are not in the claims and thus are irrelevant to the grounds of rejection. Accordingly, this argument is not persuasive.

MSA

  
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